

TOLER SCHAFFER, LLP
8500 Bluffstone Cove, Suite A201
Austin, TX 78759
Ph. 512-327-5515
Fax 512-327-5575

RECEIVED
CENTRAL FAX CENTER
AUG 01 2007

FACSIMILE COVER SHEET

DATE: August 1, 2007

TO: M/S Petitions

FAX NO.: 571-273-8300

ATTN: PAUL SHANOSKI

FROM: Jeffrey G. Toler
Reg. No.: 38,342

RE U.S. App. No.: 10/763,572, filed January 23, 2004

Applicant(s): Chung Yi-Chen

Att'y Dkt No.: 1087-PROT0005

Title: INTERPOLATIVE INTERLEAVING OF VIDEO IMAGES

NO. OF PAGES (including Cover Sheet): 26

MESSAGE:

Attached please find:

- ☒ Transmittal Form (1 pg)
- ☒ Renewed Petition to Withdraw Holding of Abandonment and attachments (24 pgs)

CONFIDENTIALITY NOTE

The pages accompanying this facsimile transmission contain information from the law office of Toler Schaffer, L.L.P. and are confidential and privileged. The information is intended to be used by the individual(s) or entity(ies) named on this cover sheet only. If you are not the intended recipient be aware that reading disclosing copying distribution or use of the contents of this transmission is prohibited. Please notify us immediately if you have received this transmission in error or the number listed above and return the document to us via regular mail.

8500 Bluffstone Cove
Suite A201
AUSTIN, TEXAS 78746

Tel: (512) 327-5515
Fax: (512) 327-5575
www.tolarschaffer.com

AUG. 1. 2007 2:51PM

TOLER SCHAFFER

RECEIVED
CENTRAL FAX CENTER

NO. 221 P. 2

AUG 01 2007


PTO/SB/21 (04-07)


Approved for use through 09/30/2007. OMB 0851-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/763,572
	Filing Date	January 23, 2004
	First Named Inventor	Chung Yi-Chen
	Art Unit	2622
	Examiner Name	KOSTAK, Victor R.
Total Number of Pages in This Submission	Attorney Docket Number	1087-PROT0005

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks Customer No.: 60533		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Toler Schaffer, LLP		
Signature			
Printed name	Jeffrey G. Toler		
Date	8-1-2007	Reg. No.	38,342

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:	
Signature	
Typed or printed name	Suzanne Nobert-Wilkerson
Date	8-1-2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ATTORNEY DOCKET NO.: 1087-PROT0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Chung Yi-Chen

Title: INTERPOLATIVE INTERLEAVING OF VIDEO IMAGES

App. No.: 10/763,572

Filed: January 23, 2004

Examiner: KOSTAK, Victor R.

Group Art Unit: 2622

Atty. Dkt. No.: 1087-PROT0005

Confirmation No.: 4877

RECEIVED
CENTRAL FAX CENTER

AUG 01 2007

ATTN: PAUL SHANOSKI

M/S Petitions

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Dear Sir:

This is a Petition to Withdraw Holding of Abandonment for the above referenced application (the "Application") under the reasoning of *Delgar v. Schulyer*; or, in the alternative, this is a petition to revive the Application under 37 C.F.R. 1.137(a); or, in the alternative, this is a petition to revive the Application under 37 C.F.R. 1.137(b).

Background

A Notice of Abandonment mailed January 22, 2007 states that the Application was held abandoned based on the Applicant's failure to timely pay the issue fee and publication fee within the statutory period of three months from the mailing date of the Notice of Allowance. Applicant submitted a Petition to Withdraw Holding of Abandonment (the "First Petition") on March 8, 2007. The issue fee and publication fee were submitted with the First Petition.

The Office of Petitions, in a Decision on Petition mailed June 7, 2007, dismissed the First Petition. The Decision stated that the reasoning of *Delgar v. Schulyer* was not relevant to this

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents on 8-1-2007.

Suzanne Nobert-Wilkerson
Printed Name


Signature

ATTORNEY DOCKET NO.: 1087-PROT0005

case because "Petitioner is attempting to establish that a mailing was not received from another law firm" rather than from the Office. Applicant respectfully disagrees.

Delgar v. Schulyer

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971) ("Delgar") (attached as *Exhibit A* - pinpoint page references to Delgar are based on the pagination of Exhibit A), several cases were presented to the court indicating that in some instances where applications became abandoned allegedly as a result of the applicant's representative not receiving the Notice of Allowance, the Commissioner granted issuance of a new Notice of Allowance. Based on these cases, the attorney representing the Patent and Trademark Office argued to the Court that a rule could be derived from these decisions. That rule was "[i]f there is any positive indication in the application filed [sic], itself, that the Patent Office may have not properly mailed a notice of allowance, then the Commissioner will grant relief. But if there is no such indication, no such positive indication of improper mailing by the Patent Office of the Patent Office application, and there is only the allegation that the applicant did not receive the notice of allowance, then the relief is denied." *Delgar*, p. 9.

Regarding the present Application, there is indication within the Application file itself that the Patent Office did not properly mail the Notice of Allowance. Specifically, the Application file wrapper indicates that on November 22, 2005 the Office received a letter from Gary J. Edwards, acting as authorized representative for the Applicant, requesting that "All future correspondence be mailed to:

Jeffery Toler
IP Legal Services
5000 Plaza on the Lake, Suite 265
Austin, TX 78746
Ph: (512) 327-5515"

Exhibit B-Request to Withdraw as Attorney of Record

Despite the fact that the Office was notified that the matter had been transferred to another attorney, and despite the fact that the Office had been properly instructed by the Attorney

ATTORNEY DOCKET NO.: 1087-PROT0005

of Record to send future correspondence to another address, the Office persisted in sending correspondence to the old address. The Office appears to have treated the letter from Mr. Edwards as a petition, in spite of the fact that nothing in the letter states that Mr. Edwards was filing a petition and no petition fee was paid. As such, the Office sent a Decision on Petition to Mr. Edwards to deny the Request to Withdraw as Attorney of Record and continued to send correspondence to the old address, Mr. Edwards' address of record.

Under 37 C.F.R. §1.33(a)(2), the correspondence address associated with an application may be changed by the Attorney of Record. In discussing Petitions Related to Abandonment, the Manual of Patent Examining Procedures, at §711.03(c)(II)(C)(2), sets forth a list of papers that are not acceptable to change the correspondence address associated with an application. This section states:

"For example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

- (A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;
- (B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or
- (C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address."

M.P.E.P., §711.03(c)(II)(C)(2).

ATTORNEY DOCKET NO.: 1087-PROT0005

Mr. Edwards' letter clearly stated that a change of correspondence address was being made, did not list plural applications, and was not belated notification to the Patent and Trademark Office. Hence, Mr. Edwards properly filed a change of correspondence address with the Patent and Trademark Office as of November 22, 2005. However, the Office mailed the Notice of Allowance on September 21, 2006 to Mr. Edwards' address not to the address listed in Mr. Edward's change of correspondence address. Thus, under the reasoning of *Delgar*, as argued by the Patent Office and accepted by the Court, there is an indication within the Application file itself that the Office did not mail the Notice of Allowance properly, and therefore, a new Notice of Allowance should be issued.

Further, in *Delgar*, the Court granted relief to the applicant despite there being no indication in the application file itself that the Patent Office had made a mistake in mailing the Notice of Allowance. The Court stated that "because of the fair administration of law by the Patent Office, it would permit these rare situations to be accommodated instead of relying on the strict letter of the statutes." *Delgar*, p. 10. Thus, even if the Office determines that it was not in error in sending correspondence to Mr. Edwards, a new Notice of Allowance should be issued in the interest of "fair administration of the law by the Patent Office," since the Applicant did not have a fair opportunity to respond to the Notice of Allowance because the Applicant's representative did not know that the request to change the correspondence address had been denied, or that the Notice of Allowance had been mailed.

Applicant respectfully submits that the Application is not in fact abandoned under the reasoning of *Delgar*. The Applicant's representative did not receive the Notice of Allowance as a result of the Notice of Allowance being improperly mailed by the Patent Office. In the alternative, under the reasoning of *Delgar*, a new Notice of Allowance should be mailed in the interest of fair administration of the law since the Applicant's representative did not know that the correspondence address had not been changed, and did not know that the Notice of Allowance had been mailed.

ATTORNEY DOCKET NO.: 1087-PROT0005

The following statement of facts is filed in support of the petition:

- 1) The file jacket for the Application, maintained by the Applicant's representative, does not include any indication of receipt of the Notice of Allowance or of receipt of the Decision on Petition denying the change of address, as supported by the copy of the file index for the Application submitted with the First Petition.
- 2) The docket records for the Application, maintained by the Applicant's representative, do not include any indication of receipt of the Notice of Allowance or of receipt of the Decision on Petition denying the change of address, as supported by the printout of the docket record for the Application submitted with the First Petition.
- 3) The Applicant's representative only became aware of the Notice of Allowance and of the holding of abandonment on February 7, 2007 upon receiving a letter from Gary J. Edwards of Finnegan.
- 4) The Applicant's representative only became aware of the Decision on Petition mailed June 11, 2007 upon receiving the Decision on Petition related to the First Petition.
- 5) The file wrapper history maintained by the Patent and Trademark Office and available via PAIR indicates that on November 22, 2005 the Office received a request from Gary J. Edwards to change the correspondence address associated with the Application. (Exhibit B-Request to Withdraw as Attorney of Record).
- 6) The file wrapper history maintained by the Patent and Trademark Office and available via PAIR indicates that the Office did not mail the Notice of Allowance to the correspondence address indicated by Mr. Edwards. (Exhibit C-Notice of Allowance).

ATTORNEY DOCKET NO.: 1087-PROT0005

- 7) The required issue fee and publication fee have already been filed.

The Application became abandoned as a result of the Patent and Trademark Office failing to change the correspondence address associated with the Application despite having received a proper request to change the correspondence address from the Attorney of Record, and as a result of the Office failing to properly mail the Notice of Allowance to the correspondence address that should have been associated with the Application. Accordingly, the reasoning of *Delgar v. Schulyer* applies in this situation. Applicant requests the Commissioner to grant this Petition to Withdraw the Holding of Abandonment under the reasoning of *Delgar v. Schulyer*.

Unavoidable Delay

In the alternative, if it is determined that the holding of abandonment may not be withdrawn based above stated facts, Applicant hereby petitions the Commissioner to revive the Application under 37 C.F.R. 1.137(a) as being unavoidably abandoned. Applicant submits based on the above facts that the entire delay in the payment of the issue fee and publication fee was unavoidable because the Applicant's representative was not aware of the Notice of Allowance and was not aware that the change of correspondence address had been denied. Further, under M.P.E.P. §711.03(c)(II)(C)(2), Mr. Edwards' request to change the correspondence address associated with the Application is adequate to demonstrate unavoidable delay.

Unintentional Delay

In the alternative, if it is determined based above stated facts, that the entire delay in filing the issue fee and the publication fee was not unavoidable, Applicant hereby petitions the Commissioner to revive the Application under 37 C.F.R. 1.137(b) as being unintentionally abandoned. Applicant submits based on the above facts that the entire delay in the payment of the issue fee and publication was unintentional since the Applicant's representative was not aware of the Notice of Allowance, was not aware that the change of correspondence address had been denied, and there was no intent to abandon the Application.


ATTORNEY DOCKET NO.: 1087-PROT0005

RECEIVED
CENTRAL FAX CENTER**AUG 01 2007****Conclusion**

The Commissioner is hereby authorized to charge the appropriate petition fee to Deposit Account Number 50-2469. While no additional fees are believed necessary, the Commissioner is hereby authorized to charge any other fees which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

8-1-2007
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant(s)
TOLER SCHAFFER, L.L.P.
8500 Bluffstone Cove, Suite A201
Austin, Texas 78759
(512) 327-5515 (phone)
(512) 327-5575 (fax)

ATTORNEY DOCKET NO.: 1087-PROT0005

INDEX OF EXHIBITS

Exhibit A - *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971)

Exhibit B - Request to Withdraw as Attorney of Record from Gary J. Edwards

Exhibit C - Notice of Allowance

AUG. 1. 2007 2:52PM

TOLER SCHAFFER

NO. 221 P. 11

EXHIBIT A

Service: Get by LEXSEE®
Citation: 172 USPQ 513

RECEIVED
CENTRAL FAX CENTER

AUG 01 2007

Select for FOCUS™ or Delivery



1970 U.S. Dist. LEXIS 9062, *; 172 U.S.P.Q. (BNA) 513

DELGAR INC. et al. v. SCHUYLER, Comr. Pats.

No. 1904-70

United States District Court for the District of Columbia

1970 U.S. Dist. LEXIS 9062; 172 U.S.P.Q. (BNA) 513

Dec. 22, 1970, and Jan. 4, 1971

CORE TERMS: patent, notice, mailed, allowance, mail, mailing, typed, abandoned, examiner, notice of appeal, correspondence, inquire, doll, written notice, correctly, inquiring, answered, putting, handed, exact, present case, Administrative Act, general rule, application filed, attorneys of record, particular case, telephone call, corresponding, customarily, forthcoming

COUNSEL: [*1] GEORGE R. DOUGLAS, JR., and MISEGADES & DOUGLAS, both of Washington, D.C., and NOLTE & NOLTE, A. C. NOLTE, JR., EDWARD B. HUNTER, and EVELYN M. SOMMER, all of New York, N. Y., for plaintiffs.

S. WM. COCHRAN and J. F. NAKAMURA for defendant.

OPINION BY: PRATT

OPINION

PRATT, District Judge.

Mr. Nakamura: If the Court please, this case is a patent case. It involves Section 151 of the Patent Statute. Section 151 provides that a written notice of allowance shall be mailed to the applicant.

This notice of allowance calls for payment of an issue fee. If that issue fee is not paid within six months, the application is regarded as irrevocably abandoned by operation of the statute.

Now, in the present case, the record shows that such a notice of allowance was mailed. The issue fee was not paid within the six months.

The application, therefore, in the eyes of the Patent Office, stands abandoned by operation of the statute.

Now, plaintiffs' claim for relief is based solely on their allegation that no notice of allowance was received by their attorneys.

We submit that the statute provides no basis for relief.

First of all, Section 151 does not expressly require that a notice [*2] of allowance be received by the applicant. In Section 151 there appears only the term "mail a written notice" -

The Court: Is there any provision for publication of allowances?

Mr. Nakamura: No, Your Honor, there is not.

The Court: Are they customarily published?

Mr. Nakamura: No, they are not customarily published. The notice is mailed. In the great majority of the cases, it is received. Occasionally it is not, for one reason or the other.

In this case the applicant has only alleged that it has not been received.

Now, there is a long-standing construction of the term "mail" in the Patent Office. This is a construction which excludes receipt. This is a construction which dates back at least 50 years, and long prior to the enactment of Section 151, which was enacted in 1965.

I can show Your Honor representative decisions that have been handed down by past Commissioners, Ex parte Lacey, for example, in 1920 C.D. 83, and Ex parte Glake in 1906 C.D. 159.

The Court: I take it that in this case there was a petition filed with the Commissioner?

Mr. Nakamura: That is correct, Your Honor.

If Your Honor would care to see the wording of Section 151, I have a copy [*3] of that statute here, which I am prepared to hand up.

The Court: It says that they provide for a sum constituting the issue fee, or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum, the patent shall issue. If payment is not timely made, the application shall be regarded as abandoned.

Mr. Nakamura: That is correct.

The Court: Then it says that any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof.

Is that the notice of allowance?

Mr. Nakamura: The first one is the notice of allowance. It contains an estimated issue fee.

The Court: The second notice that they are talking about is the notice that more money is due, I take it?

Mr. Nakamura: That is correct; if the printing exceeded the estimate.

The Court: Yes.

The Court: Has this type of situation ever been litigated before in court?

Mr. Nakamura: To my knowledge, Your Honor, it has not. This is the first time that the question has arisen.

The Court: Now, what you have just shown me is the statute, itself, is that correct?

Mr. Nakamura: This is the statute, itself, that is correct, Your Honor.

[*4] The Court: All right, I will hear further from you, if you like.

Mr. Nakamura: Your Honor, we submit that under normal rules of statutory construction, there being no legislative intent to include receipt in the term "mailing," that the defendant has no authority to read the term into the statute in the light of the past construction of "mail" in the situation with which we are now concerned.

The Court: What is involved in resurrecting a patent which has been put in an abandoned category? Do you have to file all over again?

Mr. Nakamura: Yes. If the applicant is willing to forego the benefit of having the earlier date, the date of his earliest application; then he can file at any time.

As in this particular case, if he filed today, the application would date from today.

The Court: What does this patent cover?

Mr. Nakamura: This is a patent on a doll, Your Honor. I believe, Your Honor, before I leave, I would like to point out that there is a drawing which accompanies the patent application. It is in the file. It is a part of Exhibit A, accompanying the defendant's motion to dismiss.

The Court: Did you file a response to the motion to dismiss?

Mrs. Sommer: [*5] Yes, we did, Your Honor. We filed an opposition to the motion to dismiss.

First, I would like to sort of point out the sequence that this case went through in the Patent Office, mostly because I think that it is very interesting.

The application was filed in December, 1965, and went through a normal course of prosecution up to the filing of notice of appeal and a brief upon appeal.

Sometime in October, specifically October 9, 1968, the examiner who was prosecuting the application called a Mr. W. S. Seward, who was a partner in Nolte & Nolte, and who was the attorney who was handling the application, and advised him that he was going to allow the case. That was October 9, 1968.

On October 10, 1968, the Patent Office sent out a paper, which is Paper 14 in this case, in which the Patent Office indicated that the prosecution in the case was closed and that a notice of allowance would shortly be forwarded. This is an official form of the Patent Office.

That form, which is Form P.O.L. 255, as I said, was mailed 10/10/68, and was addressed to Nolte and Nolte.

On that very same day another paper went out from the Patent Office, which was mailed to another address. It was [*6] mailed to the firm of Brown & Seward at 11 Park Road, New York City. That very day, two papers were mailed from the Patent Office: One, the form P.O.L. 255; the other, a Form 19. Both going to different addresses.

Thereafter, another paper was mailed from the Patent Office, this being Paper Number 15 and Form P.O.L. 37. This paper carries the date January 29, 1969, and this form is what is known as a Notice of Examiner's Amendment.

This form says pretty much the same thing. It indicates some amendments that the examiner is entering pursuant to a conference had with Mr. Seward on 10/10/68, and says a notice of allowance will be forthcoming.

~~I think that this paper, which was addressed to Nolte and Nolte at 330 Madison Avenue, is interesting, because it carries not only the notation that the paper was typed on 10/31/68, but it was mailed on January 29, 1969.~~

I would like to point out that I mentioned that one paper was mailed to another address in this period. Two additional papers were mailed to Brown and Seward at 11 Park Road.

The Court: Who was the attorney for the applicant?

Mrs. Sommer: Originally, attorneys of record were Brown and Seward. During the prosecution, [*7] an associate power of attorney was filed, making Nolte and Nolte the attorneys of record.

I would like to point out, for example, that when notice of appeal was filed in this case, the notice of appeal carries an express written - typed notice which says:

All correspondence is to be addressed to Nolte and Nolte, 330 Madison Avenue.

The very next paper which was mailed by the Patent Office, which is what we call the appeal receipt, that gives the appeal number and which was mailed within about a week of that date, is mailed to Brown and Seward at 11 Park Road.

Despite the fact that the notice of appeal carries the express note: All correspondence to go to Nolte and Nolte, the appeal receipt was mailed to Brown.

So, we have a course of conduct throughout of the Patent Office's sending correspondence to different addresses.

Fortunately, the mail was rerouted by the Patent Office and the papers that I am referring to were received in the Office of Nolte and Nolte at 330 Madison Avenue.

I also want to point out - because the Patent Office made a big issue of the fact that notices of allowance are typed on one day and they carry the next mailing day and they are mailed [*8] out. It is presumed that they are mailed out on the next day - that the form P.O.L. 255, which I mentioned before, carries the typing date 10/31/68 and was mailed January 29, 1969. In other words, some three months later, this was mailed out of the Patent Office.

Mr. Nakamura, counsel for the Patent Office, mentioned that the rule which is involved, or the statute which is involved, is 35 U.S.C. 151, and that this requires that the notice of allowance be mailed.

Specifically, the statute says, "Mailed or given."

I have a copy of the statute here and the patent laws. It says, "If it appears that the applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant."

In other words, I think that it connotes a little bit more than just putting it in the mailbox. It connotes that it is either given or mailed. In other words, both terms appear in the statute.

Furthermore, the Patent Office has promulgated its own rules in connection with notice of allowance. An the rule is a little different than the Patent Office and puts a stricter construction - I am sure that I have the rule - yes. The rule [*9] which is involved, and this is from the Patent Office Rules, is Rule 311, and it is noted under "Notice of Allowance: If upon examination it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him."

If the word "sent" is looked up in the dictionary - and we mentioned this in some of the papers - it indicates more than mailed. It indicates that it is going to be received.

Also, in connection with mail given or sent, Mr. Nakamura cited some cases.

We would like to point out that this very court, the District of Columbia, has, in a decision, Creasy versus the United States, and that is 4 F.Supp. 175, D.C.-Va. 1933, expressly set out that there is no notice unless it is received.

In other words, just merely putting it in the mail is not notice. The notice must be received.

The Court: Mrs. Sommer, did you receive the January 29th letter, that is January 29, 1969, that the application was being passed to issue by the examiner?

Mrs. Sommer: Yes, sir, we did.

The Court: What did you do when you got that?

Mrs. Sommer: We got that. I happen to have a copy of the correspondence here with me. Mr. W. S. Seward, [*10] who was a partner in the firm of Nolte and Nolte, was handed that in the course of - in other words, the mail is opened in a very specific manner. The papers are entered and a record is made of all mail that is received. If there is anything that the applicant must do - in other words, if there is anything that we have to do, the office has to do - it is entered onto the outside of a file, and on the outside of the file, the date that the thing came in and the date for response appears.

Nothing appears on this outside of this file after the fact that an appeal brief was entered. There was an amendment also entered, which also appears.

There is no indication of notice of allowance receipt, because it was never received.

The Court: Is there any indication that the January 29th letter was received?

Mrs. Sommer: No; the only indication is that we have it and have the letter written by Mr. Seward, in which he advised the client that this notice had been received. There is nothing for the applicant to do when that is received.

The Court: What is the normal time span between this kind of a communication and the receipt of the notice of allowance?

Mrs. Sommer: Well, [*11] we have cited a case in this case. The patent is Tran Van Khai Patent. I have the number. It is Number 3498764. An instance there was 13 days.

We have also mentioned patent applications in our own file, where it has gone up to eight months. There is no statutory requirement that we inquire.

In other words, if a normal office action is received that there has been a notice promulgated by the Patent Office which says that within two months if nothing has happened you should write a status letter.

There is no requirement with respect to this notice that a patent will be issued on inquiring.

The Court: Don't most people, when they do not get the notice of allowance, promptly get on the telephone or write a letter or do something about inquiring about where it is.

Mrs. Sommer: I would say no.

In the same file, Tran Van Khai, which we referred to, the same procedure arose, and it is not conventional to inquire. Not in this.

~~The Court: It is my experience in dealing with the Government that if you know a letter is coming and you do not get it, you get on your horse.~~

Mrs. Sommer: We are now inquiring at the end of two months.

The Court: It does not matter whether [*12] it is the Patent Office, or any other branch of Government: The Federal Power Commission, the Federal Communications Commission, Internal Revenue, any of these. If you know that something is going to happen and it does not happen and you have not received it, why, I think it is par for the course to call up and say: Look, we missed something.

Mrs. Sommer: Well, I have to admit that previous to this we had - in some cases the attorney would keep a record. Then he would inquire. But it was no general rule. We now have the general rule in the office that the Docket Clerk inquires at the end of two months.

I wanted to make another point in this case: There are a number of decisions in which this same issue came up, where the notice of allowance allegedly was not received. These decisions are in no way made public. In other words, they have not been published. This Tran Van Khai Case I referred to.

Mr. Nakamura served Mr. Douglas yesterday with a paper, Opposition by Defendant to Plaintiffs' Motion for Summary Judgement, in which a noted decision is mentioned, in which, in fact, the decision appears as Exhibit C, all going to this point of late payment of final fee.

And [*13] there is another one. I have the Patent Application Number. I do not have the number of the issued patent.

None of these decisions have ever been published by the Patent Office, by the agency. There is no record of them.

We would like to point out, therefore, that these decisions can not be relied upon, whether they are positive or negative, really, by the Patent Office, since there has been no notice, as is required by the Administrative Act and by the Public Information Section of the Administrative Act, which says that, specifically 552 under 2 (a), that each agency, in accordance with published rules, shall make available for public inspection a copy (a) a final opinion; (b) those statement of policy and interpretations which have been adopted by the agency and are not published by the Federal Register, so on and so forth. None of these decisions. There is a large number of them. We have referred to three right here. We can mention three right here. One of which for the first time I saw this morning, because I saw these opposition papers this morning. Two of which were obtained for us by Mr. Douglas through personal contacts.

In other words, you would never know [*14] that the Commissioner had decided favorably, and had decided favorably in the Tran Van Khai Case, which is the exact same as the instant case; the exact same facts existant that Commissioner Reynolds decided in October 1969, I believe it was, that another notice of allowance would be forthcoming.

His decision is very simple. He says: On the facts in the case. His decision is dated October 30, 1969. It is in the file of U.S. Patent 3498764. He says: The renewed petition filed October 17, 1969, for the acceptance of a final fee in the above-entitled application has been considered. On the basis of the entire record, as now presented, it is thought proper to hold that a notice of allowance of the application was not duly mailed on November 15, 1968. Accordingly, the present action is to be treated as such a notice of allowance. Since the issue fee was paid on July 10, 1969, the patent will be issued in due course. The petition is granted to the extent indicated.

There is another one where the exact situation arose. Again Commissioner Reynolds issued the patent.

In other words, the Commissioner has, in situations which parallel this case on all fours, subsequently permitted [*15] the payment of the final fee which was due and issued a notice of allowance. The loss of a patent. I do not believe that it is germane to the issue, but we mentioned that this is a patent for a doll; specifically, it is for a walking doll, and a very important doll.

This application form has licenses all over the world.

In other words, I do not want to mention the assignee, because that gets into particulars which are not germane.

This is a very commercial patent; extremely important.

If the patent does not issue, we are now in the situation where there is really nothing under the recent decisions on know how and secret information, and so on. There is nothing left.

This patent has issued. For example, there are corresponding patents in other countries in the world. There is for sure I know in Germany. I am not sure of the other countries. As I say, it has been licensed all over the world.

The applicants have exhausted their remedy in the Patent Office and have filed petitions, renewed petitions, all of which have been denied by Assistant Commissioner Kalk on the grounds, first of all, that the statute prevents him from acting otherwise.

I just pointed out [*16] at least two cases where Assistant Commissioner Reynolds has also, as an arm of the Patent Office, decided differently.

Also, the Patent Office feels that just mailing it and putting a copy of the notice of allowance with the word "mailed" on it is all that the Patent Office has to prove.

We have set out in considerable detail what the Patent Office does with respect to mailing a notice of allowance.

Number One, they send it to a typist, who types it on the day before it is dated. The typist in our case would have typed it. In all cases, it is universal procedure. Types it on one day, but types in another date. The thing is then sent to the mail room, and presumably is mailed out from the mail room. No record of it is made in the mail room; of its receipt in the mail room or of its actual mailing.

Any record which is entered into the file is entered from a card or tape which is made in the Notice of Issue Branch; not from the mail room.

So, we, as in Tran Van Khai, where they were sustained, where the appellant was sustained, do not believe that the Patent Office can rely on their saying that they just mailed it and that they have a record that they mailed it.

[*17] I pointed out in one case where they say that it was typed on one day and mailed three months later, in our own file. This presumably was typed one day and mailed the next day. It was never received in our office. There is no record of it anywhere.

I also want to point out that Mr. Nakamura said that usually these things are received. But there are instances where they are not received; where they are not correctly addressed, or misdirected, or who knows what, and get into the wrong office.

We do not feel that we have to establish that. We just have to prove that we never received it. It was never received in the office.

Inquiry was made at the Patent Office in connection with the prosecution of another application in another country, a corresponding application in another country.

Mr. Seward, who was handling it - I remember, it was Loudon against the United States - he went and got the United States' file and saw that there was no notice of allowance. Then immediately the petition was filed.

The Court: Mr. Nakamura.

Mr. Nakamura: If I may, Your Honor, I would like to add some comments in rebuttal here.

First of all, with reference to these decisions in [*18] other patents which Mrs. Sommers has referred to, and with reference, also, to her argument with respect to the Administrative Procedure Act, I would like to point out this: That these two decisions that she mentioned are in the patent files. As such, they are available to the public.

Now, it is true that we have not indexed them. But as Your Honor will appreciate from the number of cases which have come up on this point, it apparently would be a burden on the Patent Office to index such decisions.

Now, with respect to the first of those cases, the Tran Van Khai Case, I believe, is mentioned by Mrs. Sommer.

I would like to point out this fact, that the attorney in that case complained not only that he did not receive the notice of allowance, but he also complained that the firm was not shown correctly in the address.

So, in this case there was some possible indication that the Patent Office had not very properly mailed the notice of allowance.

The Court: Mr. Nakamura, the reason that Mr. Reynolds accepted the final fee in the Tran Van Khai Case was because of the fact that he was satisfied that the notice of allowance had not been received; is that not true?

Mr. [*19] Nakamura: Had not been duly mailed, Your Honor. I believe that was the comment.

The Court: He said not duly mailed?

Mr. Nakamura: Not duly mailed.

If one looks to the reasons that supported the attorney's petition - in my copy here, it would be on the 4th page, after the decision of Commissioner Reynolds; then the next to the last sentence of the petitioner says: If the Patent Office actually mailed a notice of allowance in the present case, how can it be so sure that it was mailed to the applicant's attorney, as 35 U.S.C. 151 requires, especially when it is ruled that the Patent Office copy of the notice of allowance did not even show the attorney's name correctly.

The Court: In this case, your own record shows that notice of allowance was mailed on a certain date?

Mr. Nakamura: Yes, it does, Your Honor.

The Court: It shows to whom it was mailed?

Mr. Nakamura: Yes, that is correct.

The Court: To Nolte and Nolte?

Mr. Nakamura: That is correct. We have a copy in the file papers that, perhaps, Your Honor may be interested in seeing just what that notice of allowance looks like. I have the actual application file here.

The Court: What was mailed was presumably [*20] a carbon of that, I take it?

~~Mr. Nakamura: Yes, Your Honor; this is the original, and a carbon is mailed as a matter of practice.~~

There is one other point that I would like to make, Your Honor:

In our opposition, which was filed yesterday, there is attached Exhibit B, which is the last decision of the Assistant Commissioner in this particular case.

I would like the Court to note that in the last line on the first page Commissioner Kalk says: Petitioners are apparently the only ones who have complained about not receiving a notice of allowance mailed on February 20, 1969. 331 were mailed that day.

There is just one statement that I would like to make in closing, Your Honor:

There is a reason why Assistant Commissioner Reynolds allowed the petitions in the two cases that Mrs. Sommer has mentioned. There is equally a good reason why the petition in this case was denied.

The distinction is this: If there is any positive indication in the application filed, itself, that the Patent Office may have not properly mailed a notice of allowance, then the Commissioner will grant relief. But if there is no such indication, no such positive indication of improper mailing by the [*21] Patent Office of the Patent Office application, and there is only the allegation that the applicant did not receive the notice of allowance, then relief is denied.

The Court: Your proof of mailing is the possession of the ribbon copy of the notice of allowance, which is part of your file?

Mr. Nakamura: That is correct.

The Court: The fact of mailing the notice is entered some place else?

Mr. Nakamura: Yes, it is. It is on the face of the application filed. I don't know whether Your Honor noticed that. In the lower righthand corner there is a stamped in date of February 20, 1969.

There is a block there, I believe, that is labeled "Notice of Allowance." Date mailed: February 20, 1969. That is the date that it was mailed.

The Court: Who put that on there?

Mr. Nakamura: This would be placed on there by the issuing branch.

The Court: But they have no other record other than having put that stamp on there, is that correct?

Mr. Nakamura: Other than having kept a tally of the total number which were mailed that day, or each day, there is no record kept on specific applications.

The Court: Mr. Nakamura, is there any particular pattern about when notices of [*22] allowance are issued?

Mr. Seward's affidavit has four cases cited, one of which has an allowance notice sent after 13 days; another one was a month and 20 days; another one was four months and 21 days; another one is eight months and three days.

With respect to one of these, they mention a status letter which was sent and brought no response. The second status letter brought a telephone call from the examiner, giving the date of allowance, stating that the application was abandoned for failure to file an issue fee. In that case a petition to review is pending.

Mr. Nakamura: In answer to your question, Your Honor, there is no period, I believe, that one can count on ~~from notification to the mailing of the notice of allowance. It fluctuates. It depends upon the work load. It~~ depends upon the people there that particular day; whether they have gotten behind. I am afraid that it is not a preditable figure.

The Court: What about the status letters and telephone calls?

Mr. Nakamura: Telephone calls would be answered. Status letters generally are answered. But I would not say that they are invariably answered. That would not be correct.

The Court: What would be [*23] the effect on the Department if the rule were other than requiring the notice to be mailed, but also require that it be received?

Mr. Nakamura: Then I believe that we would have to grant a petition in every case that comes into the Patent Office complaining about failure to receive notice of allowance.

The Court: How many of those have you had in the past?

Mr. Nakamura: There are probably not too many, but I would not say for sure. I can say this much; that - well, no, I don't think that is a very good estimate. I was going to say that in addition to the two cases that I handed up to you, there is one other published Commissioner's Decision that I know about. There are a few others, but they all date back to the 1920's or earlier.

The Court: Those are Patent Office Gazette reported cases?

Mr. Nakamura: That is correct.

The Court: What I was thinking about is in you normal experience does this happen very often? There may have been some cases in situations where this has happened, and because of these decided cases they have not taken it further; or the subject matter might not have been sufficient to warrant going further. I was just wondering, as a matter of general [*24] experience, does this happen very often?

Mr. Nakamura: I am not personally experienced in this, Your Honor. But I am quite sure that there are, from time to time, cases coming up on this point. Just from casual conversation, I know this personally.

The Court: Well, I think that I have heard enough. I am going to deny the Government's motion to dismiss and grant the plaintiffs some kind of relief.

I am going to require the plaintiff to work out the form of the order with Mr. Nakamura, so that it will do the least damage to the Department's practice.

The reason why I am ruling as I am is because it is difficult for me to believe that the notice was or was not received, when these people, who have every interest in its receipt, apparently acted on the assumption that it never came.

I am perfectly willing to admit that the language of the statute and the decisions of the Patent Office are just as you stated, Mr. Nakamura.

But I think that in the rare case, such as this, that comes up, that, because of the fair administration of law by the Patent Office, it would permit these rare situations to be accommodated instead of relying on the strict letter of the statute.

[*25] So, I will charge you, Mrs. Sommer and Mr. Nakamura, to work it out and I will sign an order on it.

The reason that I am requiring you to do that is because of the fact that Mr. Nakamura is with the Patent Office and he has an important position down there. I am sure that he would not agree to an order that ~~would go further than it has to. I do not know enough about patents to take the responsibility or trust my own judgment.~~

RECEIVED
CENTRAL FAX CENTER
AUG 01 2007

Mrs. Sommer: Thank you, Your Honor.

Mr. Nakamura: I believe that I understand Your Honor.

Jan. 4, 1971

ORDER

Upon consideration of the defendant's Motion to Dismiss and the plaintiffs' Motion for Summary Judgment and the hearing thereon, It is by the Court this 31st day of December 1970,

Ordered that (1) the defendant's Motion to Dismiss herewith is denied, (2) the plaintiffs' Motion for Summary Judgment herewith is granted, and (3) the defendant herewith is authorized to issue a notice of allowance in plaintiffs' patent application Serial No. 513,380, in suit.

Service: Get by LEXSEE®

Citation: 172 USPQ 513

View: Full

Date/Time: Friday, July 27, 2007 - 11:32 AM EDT

* Signal Legend:

- - Warning: Negative treatment is indicated
 - ◻ - Questioned: Validity questioned by citing refs
 - ▲ - Caution: Possible negative treatment
 - ◆ - Positive treatment is indicated
 - Ⓜ - Citing Refs. With Analysis Available
 - Ⓢ - Citation information available
- * Click on any Shepard's signal to Shepardize® that case.



LexisNexis®

[About LexisNexis](#) | [Terms & Conditions](#)

[Copyright © 2007 LexisNexis](#), a division of Reed Elsevier Inc. All rights reserved.

EXHIBIT B

AUG. 1. 2007 2:54PM

TOLER SCHAFFER

NO. 221 P. 24



PATENT
Customer No. 22,852
Attorney Docket No. 9182.0005-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

CHUNG, Yi-Chen

Application No.: 10/763,572

Filed: January 23, 2004

For: INTERPOLATIVE INTERLEAVING OF
VIDEO IMAGES

)
)
) Group Art Unit: 2614
)
) Examiner: MILLER, John W.
)
)
) Confirmation No.: 4877

RECEIVED
CENTRAL FAX CENTER
AUG 01 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

I hereby request to withdraw as attorney or agent for the above-identified patent application. This request is made in triplicate.

The Assignee of the above-referenced application, Protocom Technology Corporation, was acquired by SigmaTel, Inc., and has requested that the above-referenced application be transferred to their new counsel.

All future correspondence is to be sent to:

Jeff Toler
IP Legal Services
5000 Plaza on the Lake, Suite 265
Austin, Texas 78746
Ph: (512) 327-5515

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 21, 2005

By: 
Gary J. Edwards
Reg. No. 41,008

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
(650) 849-6622

EXHIBIT C



UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 01 2007

 UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

22852 7590 09/21/2006

 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
 LLP
 901 NEW YORK AVENUE, NW
 WASHINGTON, DC 20001-4413

EXAMINER

KOSTAK, VICTOR R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/21/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,572	01/23/2004	Chung Yi-Chen	9182.0005-00	4877

TITLE OF INVENTION: INTERPOLATIVE INTERLEAVING OF VIDEO IMAGES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$0	\$0	\$1400	12/21/2006

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.